R E M A R K S

A. INTRODUCTION

Claims 1-3, 5-13, 15-21, 23-27 and 29-34 are pending and rejected.

Upon entry of this Amendment:

- Claims 1-3, 5-13, 15-21, 23-27 and 29-43 will be pending (39 total claims)

- Claims 8, 9, 17, 18, 19, 26, 32, and 33 will be amended

- Claims 35-43 will be added

- Claims 1, 8, 9, 10, 17, 18, 19, 26, 32, 33, 34, and 35 will be the only independent claims (12 independent claims)

B. REQUEST FOR CONTINUED EXAMINATION

A Notice of Appeal and Pre-Appeal Brief Request for Review were filed on February 13, 2007. A Notice of Panel Decision to proceed to Board of Patent Appeals was mailed on May 8, 2007 A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

C. SECTION 102(E) / 103(A) REJECTIONS

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-34 are rejected under Section 102(e) or in the alternative under Section 103(a), in light of assertions allegedly supported by Riendeau (U.S. Patent No. 6,761,633).

Claim 12 is rejected under Section 103(a) in light of Riendeau and Sultan (U.S. Patent No. 6,273,817).

1. Claims 2 and 11

Claims 2 and 11 require printing of symbols in such a manner as to provide for potentially continuous paths to be non-continuous paths and to provide for printed symbols that indicate discontinuities in paths. Riendeau does not suggest any such functionality or such printed symbols.

In three Office Actions, the Examiner has not even asserted that Riendeau teaches symbols that cause paths to be non-continuous paths or indicate discontinuity, as provided for in Claims 2 and 11. Neither Sultan nor Riendeau teach such features. There is no suggestion that "negative symbols" Riendeau cause paths to be non-continuous or indicate discontinuity. The Examiner has never suggested otherwise. To the contrary, it is clear that a player playing the Riendeau game continues along a path even if the revealed number is negative

(i.e., a prize decrement). The rejection of Claims 2 and 11 fails for at least this reason.

The Examiner now asserts:

> With respect to claims 2 and 11, most broadly, something that is "void" by definition is "being without something specified". In Riendeau the negative symbols can be considered "void" of a positive number meeting the limitations of the claims.

[present Office Action, page 3]. The Examiner now appears to be justifying the obviousness rejections of Claims 2 and 11 because the "negative symbols" in Riendeau do not specify <u>everything</u> (i.e., "something" is not "specified").

Applicants do not agree that one of ordinary skill in the art would have considered "any symbol" or symbols "with negative signs" or symbols "'void' of a positive number" as *void symbols*, or that one of ordinary skill in the art would have interpreted the recited term, *void symbol*, as broadly as "being without something specified." There is no evidence of record that such a definition would have been known to one or ordinary skill in the art. The Examiner has not indicated a source of such a teaching.

Applicants respectfully submit that the Examiner has failed to establish a prima facie Section 102(e)/103(a) rejection for Claims 2 and 11.

2. <u>Independent Claims 1, 8, 9, 10, 17, and 18</u>

2.01. Method Claims 1 and 10 are not product-by-process claims

The Examiner asserts that independent Claims 1 and 10 must be construed as product-by-process claims (and explicitly rejects the claims based on that determination). <u>See</u> Office Action mailed March 28, 2006, page 3, C(2); present Office Action, pages 2-3. A product-by-process claim is a claim to a product itself (e.g., to an apparatus, device, manufacture or composition of matter), and defines the claimed product in terms of the process by which it is made. MPEP §2173.05(p)(I). Claims 1 and 10 claim methods (as the Examiner admits of Claim 1 at page 2 of the present Office Action) and are not claims to products (much less product-by-process claims).

2.02. The Examiner explicitly bases the Section 102(e)/Section 103(a) rejections of Claims 1 and 10 on the finding that they are product-by-process claims

The Examiner states (page 2, emphasis added):

> Examiner has interpreted claim 1 as being a product by process claim in applying the prior art.

* * *

> Note that product by process claims are not limited to the manipulations of the recited steps, only to the structure implied by the steps. MPEP 2113. As such the limitations drawn to the "game rules" do not distinguish over the prior art.

> As to claims 1, 8, 9, 10, 17 and 18 in view of Riendeau the previous grounds for rejection remains since "a game rule" does not distinguish over the applied art in terms of structure implied by the recited steps. As set forth above, these claims are not directed to a method of playing a game

The Section 102(a)/Section 103(a) rejections of independent Claims 1, 8, 9, 10, 17, and 18 (and dependent Claims 2-3, 5-7, 11-13, 15, and 16) were and still are based on the erroneous determination that method Claims 1 and 10 are product-by-process claims, and the subsequently erroneous conclusion that "limitations drawn to the 'game rules'" do not distinguish over Riendeau because such limitations do not imply "structure."

2.03. No prima facie case of obviousness has been established due to the improper construction of method Claims 1 and 10 as product-by-process claims

The Examiner has fundamentally misconstrued independent Claims 1 and 10 as product-by-process claims. Also, the determination of patentability must be based on the recited process steps, not on an end-product the Examiner believes may be produced by the steps. The Examiner has ignored particular limitations of Claims 1 and 10 because they allegedly do not imply structure to a product. Accordingly, the Examiner cannot have established a prima facie case of obviousness for any of Claims 1-3, 5-13, and 15-18.

Riendeau also does not teach or suggest all of the features of Claims 1, 8, 9, 10, 17, and 18.

Claim 1 includes a feature of

- *wherein in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols printed in the play area of the lottery ticket is selectable as an initial player selection*

Claims 8 and 9 incorporate by reference the above limitation of Claim 1.

Claim 10 includes a feature of:

- *wherein in accordance with a game rule associated with the ticket any one of the plurality of nodes printed in a pattern spanning the play area of the ticket is selectable as an initial player selection*

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Claims 17 and 18 incorporate by reference the above limitation of Claim 10.

<u>Sultan</u> does not suggest the above features, and the Examiner does not assert otherwise.

Applicants respectfully submit that in <u>Riendeau</u> not any one of the plurality of play symbols or nodes in a play area of a ticket is selectable by a player as an initial player selection. The Examiner, however, asserts (present Office Action, page 3):

> Inherently, in·Riendeau "any one of the plurality of play symbols
> ... is selectable" meeting the limitations of the claims.

Applicants do not agree. Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art. <u>Trintec Indus., Inc. v. Top-U.S.A. Corp.</u>, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002). Thus, the question raised by the Examiner is whether one skilled in the art would read any portion of <u>Riendeau</u> as <u>necessarily, not probably or possibly,</u> showing a process (or processes) that included every feature of Claims 1 and 10. The Examiner does not explain how <u>Riendeau</u> "inherently" (i.e., <u>necessarily</u>) teaches what the Examiner asserts.

To the contrary, as explained in our previous Response, in <u>Riendeau</u> a player must make a first selection at the start of the game from one of designated "nodes"—not any one of the depicted "nodes" or points in the play area may be selected at the start of the game. A player could not, for example, first select a "finishing point" in <u>Riendeau</u> or some other mid-point in the displayed branches.[1]

The Examiner has not established with substantial evidence that all of the features of independent Claims 1, 8-10, 17, or 18 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claims 1 (and its dependent Claims 2, 3, and 5-7), 8, 9, 10 (and its dependent Claims 11-13, 15, and 16), 17, or 18.

3. Independent Claims 19 and 26

Claim 19 includes a feature of

- *wherein any one of the nodes [in the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

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[1] See, e.g., Abstract ("as play progresses between <u>a</u> starting point and multiple finishing points"); FIG. 1, FIGs. 2A-2B ("START" 52); Column 7, lines 1-4 ("According to a sample game, the player's current position is marked using a marker (herein depicted as a star) at a starting point 52 (see FIG. 2A). From there the player <u>must</u> choose between a first branch 62 and a second branch 64.") (emphasis added).

Claim 26 includes a feature of

- *wherein any one of the nodes [spanning the play area] is selectable at the start of a game of the simulated scratch-off lottery ticket*

Sultan does not suggest the above features; the Examiner does not assert otherwise.

With respect to Claim 26, the Examiner asserts:

> Riendeau shows a pattern of nodes in spaces marked "01" or space marked "16" in his fig. 2A. Any one of these nodes is selectable at the start of the game as called for by claim 26.

[Office Action mailed March 28, 2006, page 4].

As discussed in our previous Response, the spaces "01" and "16" of Riendeau are not a pattern of nodes forming a plurality of available paths from the first section of the play area to a second section of the play area, as required in Claim 19; nor are they a pattern of nodes spanning a play area, as required in Claim 26. The spaces "01" and "16" are individual points that by themselves cannot span the indicated play area nor form paths—single points cannot form paths. In response to this argument, the Examiner now asserts (page 3 of the present Office Action):

> As to claims 19 and 26, applicant argues limitations which are not present in the claims (i.e, "nodes in the play area" and "spanning the play area". As such this argument is unpersuasive.

Applicants do not understand this assertion. The limitations are clearly present in the claims. Claim 19 clearly describes the recited *nodes* referred to in the wherein clause as *in a play area*. Claim 26 similarly describes the recited *nodes* as *spanning a play area*. The Examiner appears to have misread both of Claims 19 and 26 or failed to consider the subject matter of each claim as a whole.

The Examiner has not established with substantial evidence that all of the features of independent Claims 19 or 26 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claim 19 (and its dependent Claims 20, 21, and 23-25) and Claim 26 (and its dependent Claims 27 and 29-31), 32, and 33.

4.   Independent Claim 34

It is not clear that the Examiner has examined independent method Claim 34. Method Claim 34 includes a feature of: *establishing a rule of a game in which any one of a plurality of printed play symbols spanning a play area of a lottery ticket is selectable as an initial player selection in the game.*

The Examiner does not address this feature at all. Such a feature is not taught or suggested by <u>Riendeau</u> or <u>Sultan</u>, as discussed above with respect to Claims 19 and 26. Specifically, <u>Riendeau</u> does not suggest printed play symbols spanning a play area, in which any one of such symbols is selectable as an initial player selection, much less *establishing such a rule of a game*. To the contrary, <u>Riendeau</u> requires selection from particular "nodes."

The Examiner does not even assert that Claim 34 is a product-by-process claim, so it is not clear why the Examiner has ignored the claimed feature of *establishing*.

The Examiner has not established with substantial evidence that all of the features of independent Claim 34 were known or desirable. Accordingly, the Examiner has not established a prima facie case of obviousness for Claim 34.

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. NEWLY-ADDED CLAIMS 35-40 ARE PATENTABLE OVER RIENDEAU AND SULTAN

Newly-added Claims 35-40 are patentable over <u>Riendeau</u> and <u>Sultan</u> for at least the reasons presented herein. No new matter has been added. See, e.g., Specification, pages 15-20 (discussing an exemplary game in which connected or otherwise mutually associated elements reveal or expose two to five numbers that have a higher sum total than a predetermined total (e.g., twenty-one)).

Neither <u>Riendeau</u> nor <u>Sultan</u>, alone or in combination, teaches or suggests

> *wherein in accordance with a game rule associated with the lottery game any one of the plurality of game elements printed in the play area of the lottery game is selectable as an initial player selection; and*

> *displaying a total game element including an indication of a
> predetermined total value,*
>
> *wherein at least one set of two or more game elements forms a first
> potentially continuous path and a second potentially continuous
> path, such that the sum of the respective values of the two or more
> game elements of the first potentially continuous path is greater
> than the predetermined total value and the first potentially
> continuous path is associated with a prize, and wherein the second
> potentially continuous path is not associated with a prize*

as recited in new independent Claim 35. New Claims 36-40 depend from new
independent Claim 40.

For at least the reasons stated herein, we respectfully submit that new Claims
36-40 contain allowable subject matter.

F. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a five-month extension of time to respond to the Office
Action is necessary.

Please grant a petition for any extension of time required to make this
Response timely. Please also charge any other appropriate fees set forth in 37
C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: $2230.00

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Please credit any overpayment to the same account.

G.   CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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